

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

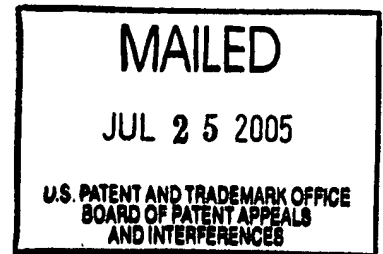
## UNITED STATES PATENT AND TRADEMARK OFFICE

### BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Ex parte DAVID L. PATTON

Appeal No. 2005-1291  
Application No. 09/534,433

ON BRIEF



Before MCQUADE, NASE, and BAHR, Administrative Patent Judges.  
MCQUADE, Administrative Patent Judge.

#### DECISION ON APPEAL

David L. Patton appeals from the final rejection of claims 12, 14, 18 through 23, 25 and 29 through 34, all of the claims pending in the application.

#### THE INVENTION

The invention relates to "the printing and verification of limited edition stamps" (specification, page 1). Representative claim 12 reads as follows:

12. A limited edition official postal stamp comprising:  
a first indicia identifying said limited edition official postal stamp as being a limited edition, wherein said first indicia comprises a unique ID that identifies said limited edition stamp as being one out of a predetermined number;

a second indicia which is not visible under normal viewing conditions for confirming that said limited edition official postal stamp is a valid limited edition official postal stamp, said second indicia is not capable of being scanned for reproduction.

#### THE PRIOR ART

The references relied on by the examiner to support the final rejection are:

Gasper et al. (Gasper)	5,919,730	Jul. 06, 1999
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"Welcome Hummingbirds by Fueling Up the Feeders," The St. Louis Post Dispatch, Five Star Edition, May 21, 1993.

"Canada Post Announces 1996 Stamp Program," The Ottawa Citizen, Final Edition, December 30, 1995.

#### THE REJECTION

Claims 12, 14, 18 through 23, 25 and 29 through 34 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Gasper in view of the St. Louis Post Dispatch article and the Ottawa Citizen article.

Attention is directed to the main and reply briefs (filed March 8, 2004 and June 16, 2004) and the final rejection and answer (mailed October 9, 2003 and May 28, 2004) for the respective positions of the appellant and the examiner regarding the merits of this rejection.

DISCUSSION

Gaspar, the examiner's primary reference, discloses a "copy restricted" original document designed to deactivate a copy machine to prevent unauthorized copying of the document. To this end, the original document includes a pattern of printed microdots 16 which are not detectable by a user under routine viewing conditions but are detectable by a copy machine. If copying is not authorized, detection of the microdots by the machine prevents the machine from generating copies. If copying is authorized, the machine proceeds to make high quality copies in which the microdots are not visible. Gaspar teaches that the microdots can take a variety of forms as long as they are substantially non-visual and machine readable, and that they can be used in conjunction with hard copy documents embodying any type of sheet media and visual information (see column 5, line 47, through column 7, line 48).

Even a cursory comparison between the subject matter disclosed by Gaspar and that recited in the appealed claims shows that Gaspar fails to meet the limitations in independent claim 12, and the corresponding limitations in independent claims 23 and 34, which define (1) the claimed subject matter in terms of a

limited edition official postal stamp, (2) the content of the first indicia as identifying the stamp as a limited edition and comprising a unique ID, and (3) the content of the second indicia as confirming that the stamp is a valid limited edition official postal stamp.

The St. Louis Post Dispatch article describes Governor's Edition 1993 Missouri Waterfowl Stamps issued by the Missouri Department of Conservation for collection by wildlife art enthusiasts. The 2,000 limited edition stamps contain sequential numbering, identification as the Governor's Edition and a space for the governor's signature.

The Ottawa Citizen article describes a series of commemorative postal stamps to be issued by Canada Post including a limited edition of 1,000 numbered copies of bird press sheets hand-signed by the designer and artist.

In proposing to combine the foregoing references to reject the appealed claims, the examiner submits that it would have been obvious at the time the invention was made to a person having ordinary skill in the art "to modify Gasper et al's document to be in the form of a stamp comprising unique indicia as taught by the St Louis Post-Dispatch for the purpose of providing a limited

edition stamp" (final rejection, pages 3 and 4), and further "to modify Gasper et al's and the St. Louis Dispatch's stamp with [a] limited edition official postal stamp as taught the Ottawa Citizen for the purpose of the stamp to be used for postal usage" (final rejection, page 4).

Arguably, the combined teachings of the applied references would have suggested utilizing the "copy restrictive" features disclosed by Gasper in a limited edition official postal stamp having a first indicia identifying the stamp as such to prevent unauthorized copying. These teachings, however, would not have suggested the first indicia as also comprising a unique ID for the stamp or a second indicia, not visible under normal viewing conditions, confirming that the stamp is a valid limited edition official postal stamp. The examiner deals with these deficiencies by (1) asserting that the recited indicia are not functionally related to the stamp and thus, under In re Gulack, 703 F.2d 1381, 217 USPQ 401 (Fed. Cir. 1983), do not distinguish the claimed invention from the prior art in terms of patentability and (2) concluding that it would have been obvious in any event to place any desirable indicia on the stamp in accordance with the stamp's intended use (see pages 4 and 5 in the final rejection). Neither of these approaches is well taken.


The first and second indicia defined in independent claims 12, 23 and 34, pertaining respectively to a unique ID for the stamp and confirmation of the stamp's validity as a limited edition official postal stamp, clearly have functional relationships with the stamp. Thus, as stated in Gulack, "the critical question is whether there exists any new and unobvious functional relationship between the printed matter [i.e., the first and second indicia] and the substrate [i.e., the stamp]" (703 F.2 at 1386, 217 USPQ at 404). The references applied by the examiner fail to establish that the functional relationships at issue are not new or unobvious. Moreover, the examiner's blanket and unsubstantiated contention that any desirable indicia would have been obvious depending on the intended use of the stamp has no basis in law or fact.

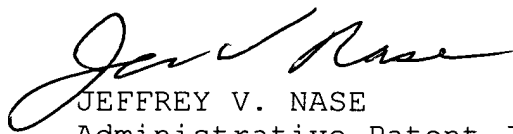
Accordingly, we shall not sustain the standing 35 U.S.C. § 103(a) rejection of independent claims 12, 23 and 34, and dependent claims 14, 18 through 22, 25 and 29 through 33, as being unpatentable over Gasper in view of the St. Louis Post Dispatch article and the Ottawa Citizen article.

SUMMARY

The decision of the examiner to reject claims 12, 14, 18 through 23, 25 and 29 through 34 is reversed.

REVERSED

  
JOHN P. MCQUADE  
Administrative Patent Judge )

  
JEFFREY V. NASE  
Administrative Patent Judge )

  
JENNIFER D. BAHR  
Administrative Patent Judge )

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Page 8

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